

123
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

04-19-04

AF/2835
PATENT APPLICATION

ATTORNEY DOCKET NO. 10014774-1

IPW
Fm 12



IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): ARLEN L. ROESNER et al.

Confirmation No.:

Application No.: 10/017,543

Examiner: CHERVINSKY, BORIS

Filing Date: 12/13/2001

Group Art Unit:

Title: THERMAL INTERFACE

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in **triplicate** is the Reply Brief with respect to the Examiner's Answer mailed on March 26, 2004. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a)).

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

(X) PLEASE SEE ATTACHED CERTIFICATE OF MAILING.

() I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, Alexandria, VA
22313-1450. Date of Deposit: _____

OR

() I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number _____ on _____

Number of pages: 2

Typed Name: MARIANNE MIDDLETON

Signature: Marianne Middleton

Respectfully submitted,

ARLEN L. ROESNER et al.

By [Signature]

LOUIS A. MOK

Attorney/Agent for Applicant(s)

Reg. No. 22,585

Date: 4/15/04

Telephone No.: (805) 373-0060



PATENT
Attorney Docket No: 10014774-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: ARLEN L. ROESNER et al.

Art Unit: 2835

Examiner: Boris Chervinsky

Serial No: 10/017,543

Filed: December 13, 2001

For: THERMAL INTERFACE

CERTIFICATE OF MAILING VIA U.S. EXPRESS MAIL

"Express Mail" Mailing Label No. EV 380174805

Date of Deposit: April 15, 2004

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

I hereby certify that

- ☒ Two copies of Transmittal of Reply Brief
- ☒ Reply Brief in triplicate.
- ☒ Return Postcard

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service with sufficient postage under 37 C.F.R. § 1.10 on the date indicated above and are addressed to:

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Date: April 15, 2004

Koppel Jacobs Patrick & Heybl
555 St. Charles Drive, Suite 107
Thousand Oaks, California 91360
Telephone: 805-373-0060
Facsimile: 805-373-0051

Marianne Middleton

Name of person mailing papers

Marianne Middleton

Signature



HP 10014774-1
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Inventors: Arlen L. Roesner, et al.
Serial No.: 10/017,543 Art Unit: 2835
Filed: December 13, 2001 Examiner: Chervinsky, Boris L.
Title: **THERMAL INTERFACE**

REPLY BRIEF
(37 CFR 1.193(b)(1))

This brief is in reply to the Examiner's Answer dated March 26, 2004.

The Examiner's Answer contains statements contrary to the express findings of the Board in its June 30, 2003, "Decision on Appeal and Opinion" (Paper No. 14).

First, the Examiner's Answer, at page 5, states:

"...having the thermal grease on one side of the carrier and phase change material on another side is still known solution as disclosed by Green, although Green suggests an improvement to that known and previously used structure".

This statement is directly contrary to the Board's finding that "Green does not disclose the elements of a thermal interface arranged as specified in appealed independent claims 1, 10 and 22." (Paper No. 14, p. 3.)

Second, the Answer, pages 5-6, asserts:

"The argument regarding claims 1, 10 and 22 stating that the layer of pliable thermal compound is not a phase change material is not convincing because claiming a phase change material and a pliable thermal compound is, in fact, addressing two different, not mutually exclusive properties of a material. Since the terms in the claims must be given broadest reasonable interpretation the pliable thermal compound does not exclude phase change material, so it can be pliable thermal compound and a phase change material or vice versa at the same time. In view of the above the Green reference is solely sufficient to reject claims 1 and 22, and claim 10 in view of Tzeng since the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference 'teach' what the subject patent teaches. Assuming that a reference is properly 'prior art', it is only necessary that the claims under consideration 'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it".

Appellants find these statements unintelligible, but to the extent any sense can be made of them, they again fly in the face of the express findings of the Board in the first appeal, namely, that Green is not an anticipatory reference and that a "phase-change material" is not the same as a "pliable, thermal compound". (Paper No. 14, page 2.)

//

//

//

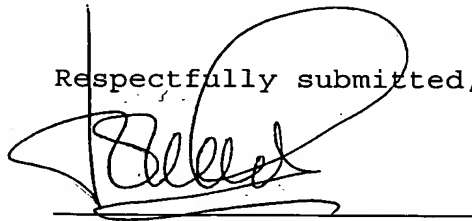
//

//

//

Once again, Appellants respectfully submit that the rejections of claims 1-30 should be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Louis A. Mok', is written over a horizontal line. The signature is stylized with a large, looping initial 'L'.

Dated: April 15, 2004

Louis A. Mok
Registration No. 22,585
Attorney for Appellants

KOPPEL, JACOBS, PATRICK & HEYBL
555 St. Charles Drive, Suite 107
Thousand Oaks, California, 91360

(805) 373-0060